

REMARKS

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 4, 6, 8-10, 12, 13, 15 and 17-24 are rejected under 35 U.S.C. §102(e) as being anticipated by Henson et al. (U.S. 6,167,383). This rejection is respectfully traversed on the grounds that the reference is defective in supporting a rejection under 35 U.S.C. §102.

Amended independent claims 1 and 10 now include: business rules including a) whether the store allows the upsell advisor, b) whether there are any upsell recommendations for a given brand of a last configurable item in the cart, c) whether a last upsell recommendation in a prescribed sequence has been presented, d) whether a given upsell recommendation match exists in the last configurable item in the cart, e) whether the upsell recommendation for an item is valid, and f) if valid, a differential price is calculated.

The PTO provides in MPEP § 2131... "To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Henson et al.* patent must contain all of the claimed elements of independent claims 1 and 10. However, the claimed business rules as defined above are not shown or taught in the *Henson et al.* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

For these reasons, the rejection of independent claims 1 and 10, as now amended, should be withdrawn. Applicant submits that independent claims 1 and 10, along with the claims dependent therefrom, are allowable over *Henson et al.*

Applicant further submits that the reference is defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because *inter alia*, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The “difference” may have seemed slight (as has often been the case with some of history’s great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness *vel non* of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

In the present case, the reference fails to teach all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 10 have not been met by the *Henson et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that remaining claims 1, 3, 4, 6, 8 - 10, 12, 13, 15, 17 - 24 distinguish over the cited reference. Accordingly, the claims are in condition for allowance and an early Notice of Allowance is courteously solicited.

PATENT

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Respectfully submitted,



James R. Bell
Registration No. 26,528

Dated: 3-28-05
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

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